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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,141	01/17/2002	Jin-Yong Joo	122990-05163075	3416
23429 7590 07/10/2008 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314				
EXAMINER CARLSON, JEFFREY D				
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3622				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/763,141

**Applicant(s)**

JOO ET AL.

**Examiner**

Jeffrey D. Carlson

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- 7) ☐ Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

This action is responsive to the paper(s) filed 4/16/08.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 7, it is unclear whether the "depriving" is a positive step or an optional one because it is apparently only performed "when the email is confirmed..."

#### ***Foreign Priority***

Applicant has responded with a translation perfecting the foreign priority to 3/30/1999. However the priority document does not appear to fully support all of the presented claims. Therefore the claims that include the following unsupported features cannot enjoy the earlier benefit date and in turn are rejected as done previously:

- The feature of inserting the advertisement in the ground of the email (claims 2, 4). The priority document describes insertion of the advertisement in the background of a chatting window, but is silent on insertion in the "ground" of an email.

-- The feature of a sender choosing kind, content and form of the advertisement (claim 5). The priority document describes choice between various ads, but not to the degree claimed; the user chooses ads not content.

**3. Claims 2, 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US20010047294).**

Regarding claim 5, Rothschild teaches the concept of allowing an email sender to send an email message that includes a sender-chosen advertisement to an email recipient. Both the sender and receiver may be compensated for the advertising [abstract, para 0021, 0022]. While Rothschild appears to describe a typical "webmail" application [0047] where the mails are delivered from the server, the system can also be described as one where the sender's PC transmits the emails because the sender's PC is the one which presses the "send" button and authorizes the delivery of the email. Without the sender's PC, no mail would be transmitted. However, Rothschild also teaches that the recipient may use a typical desktop email client such as Microsoft Outlook™ and it would have been obvious to one of ordinary skill at the time of the invention to have provided the ability for senders to transmit emails with desktop clients as well for users more comfortable with an application program rather than webmail. When an advertisement is chosen and included with the email, it can be said to be an "activated" advertisement now included with the email. Rothschild describes that the server can collect information regarding the sending and receiving/interacting of the advertisements and the system will compensate the user's accordingly [0054, 0056,

0057]. In the case where the sender uses a desktop application, such notifications would be delivered to the server from the client PC.

Regarding claim 2, Rothschild teaches that ads may include embedded URLs; these are taken to represent ads inserted into the ground of the email. However, HTML-formatted emails are well known to include various HTML features including background content (in fact Outlook supports such features) and it would have been obvious to one of ordinary skill at the time of the invention to have inserted any advertising content into the foreground or background of the email as a matter of design choice. Compensating for interacting with an interactive advertisement is also taken to represent compensation for receiving the advertisement as the advertisement cannot be interacted with without its receipt. The two go hand-in-hand. Nonetheless, it would have been obvious to one of ordinary skill at the time of the invention to have compensated recipients for merely receiving a "static" ad because it is well known for advertisers to pay per advertisement "impression".

Regarding claim 4, the webmail application of Rothschild is taken to include downloading ads to the client's browser page for display and review before the personalized message is added and email is submitted for delivery. Further, Rothschild teaches that the sender may be the source for the advertisement [0049 lines 10-13].

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viral Marketing (Steve Jurvetson and Tim Draper) in view of Goldhaber et al (US5794210).**

6. Regarding claims 1-4, 9, Viral Marketing teaches the concepts of providing free email services that include viral advertising embedded within from one user to his (friends) recipients. These messages "imply endorsement" from the sender to the user and therefore are a more powerful form of advertising over ads from unknown senders. Viral Marketing also teaches that the "customers (senders) do the selling" of the advertised products and the concept is likened to multi level marketing where customers are treated like "distribution partners" and are paid for their word of mouth viral advertising. Viral Marketing does not mention compensating the recipient of the viral advertising. However Goldhaber et al teaches the concept of negatively priced information whereby consumer who consume advertising information are paid for their (tracked/monitored) attention [abstract]. In particular, readers of emails can be paid for their attention in reading emails [col 6 lines 3-23]. It would have been obvious to one of ordinary skill at the time of the invention to have tracked the sending, delivery and display of such viral advertising and paid not only the sender as suggested by Viral Marketing, but also the recipients as taught by Goldhaber et al. Regarding the activation of the advertising, Official Notice is taken that it is well known to provide attachments with emails and it would have been obvious to one of ordinary skill at the time of the invention to have provided the viral advertising as an attachment, or other

means, so that other well known media formats can be used for the advertising – such as audio, video, images, HTML backgrounds, rich media, etc. This would provide a more attractive advertisement over plain text. Rendering any of these formats by the recipient (or via a preview by the sender) can be considered to represent “activation” of the advertising content. Regarding the download of emails by the sender, the well-known concept of web mail as mention by Viral Marketing inherently indicates that email messages are downloaded for editing and then delivered by a server. Likewise, use of an email client provides delivery of emails from the sender PC to a server and ultimately to a user’s PC who may also optionally use webmail or a local mail client.

7. Regarding claims 5, 8, given Viral Marketing’s teaching that the sender is endorsing the product advertised, it would have been obvious to one of ordinary skill at the time of the invention to have enabled the sender to have chosen an advertisement having content that the sender was comfortable endorsing and/or that the sender believes his recipient/friend would find beneficial. It would be predictably senseless and discouraging to have been forced to send an advertisement for a product or company for which the sender (or if the sender is aware, the recipient) carries ill-feelings.

8. Regarding claim 6, it would have been obvious to one of ordinary skill at the time of the invention for any entity to have sent an advertisement with the proposed system including a lottery provider who entices prospects with vouchers/coupons for free lottery tickets in an attempt to attract future lottery sales from the consumers.

9. Regarding claim 7, Official Notice is taken that SPAM or bulk emailing is a well known and fraudulent practice. It would have been obvious to one of ordinary skill at

the time of the invention to have deprived bad actors of compensation where they are determined to be sending countless emails to limitless recipients in an attempt to fraudulently gain the system for revenue. Allowing payments to senders who SPAM others would not only be a waste of money, but would be paying for emails that would predictably be seen by the SPAM-recipients as unwanted, doing harm to the brand being advertised.

### ***Response to Arguments***

Applicant states that there is support in the priority document for ads embedded in the background of an email, yet points broadly to four pages of disclosure which teach at best only embedding ads in a chat window. If there is a specific teach, please provide the page and line number along with an explanation if the specific claim language is not explicitly present.

Applicant argues that there is support for selecting the content of an email. The priority document describes choice between various ads, but not to the degree claimed; the user chooses ads not content.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Gabbard et al teaches a system that inserts advertising into senders emails and tracking of the viewed impressions.



Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/  
Primary Examiner, Art Unit 3622

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